



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/006,839 01/12/98 SIDIKMAN

P C0464.093809

EXAMINER

TM02/0508

KAZIMI, H

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

05/08/01

GEORGE T MARCOU
KILPATRICK STOCKTON
SUITE 800
700 13TH STREET NW
WASHINGTON DC 20005

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/006,839

Applicant(s)
Sidikman et al.

Examiner
Hani Kazimi

Art Unit
2164



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 28, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 2164

DETAILED ACTION

1. This communication is responsive to Applicant response filed on February 28, 2001.

Status of Claims

2. Of the original claims 1-18, claims 1-18 have been canceled without prejudice or disclaimer in the amendment filed on January 12, 1998, and claims 22-41 have been added in the same amendment. However, since the original claims were 1-18, the added claims 22-41 have been renumbered as 19-38 according to 37 C.F.R. 1.126. In the amendment filed February 16, 2000, claims 19, and 38 have been amended. In the amendment filed August 8, 2000, claim 38 have been canceled without prejudice or disclaimer. Therefore, claims 19-37 are under prosecution in this application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 19-37 are rejected under 35 U.S.C. § 102(a) based upon a public use or sale of the

Art Unit: 2164

invention as discussed in paragraphs 4& 5 of paper No. 16.

Response to Arguments

5. In Applicant's response, the Applicant argues in substance that;

The cited Newswire article is not available as a reference because it is owned by the same assignee (Citibank) as indicated in 35 USC § 103(c).

In response: 103(c) states;

"103(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Applicant's attention is directed to the fact that claims 19-37 are rejected under 102(a). Note that this disqualification of 102(a) type art from the same assignee only holds under 103. If the article actually anticipates the claims and can be used under 102, then the rejection can still stand under 102(a) even if they are commonly assigned. Assignee can be taken into account only if the rejection moves to obviousness type. Also, MPEP 706.02(k) states that;

"Effective **November 29, 1999**, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "**were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same**

Art Unit: 2164

person.” This change to 35 U.S.C. § 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution applications filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. § 103(c) does not affect any application filed before November 29, 1999, a request for examination under 37 CFR 1.129 of such an application, nor a request for continued examination of such an application. See MPEP § 706.02(I)(1) for additional information regarding disqualified prior art under 35 U.S.C. § 102(e)/ 103."

Applicant's arguments with respect to the art rejection have been fully considered but they are not deemed to be persuasive.

Conclusion

6. This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Serial Number: 09/006,839

5

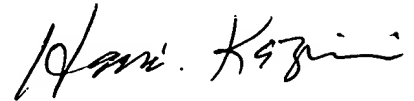
Art Unit: 2164

Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703) 308-6296 or 6306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Respectfully Submitted

A handwritten signature in black ink, appearing to read 'Hani Kazimi', written in a cursive style.

Hani Kazimi

Art Unit 2164

April 24, 2001

Serial Number: 09/006,839

Art Unit: 2164

Requirement for Information Under 37 C.F.R. 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to identify products and services embodying the disclosed subject matter of obtaining securities information and transactions for a user at an automatic teller machine. The prior art discloses that Applicants have been operating the system in a few states since at least October, 1994. However, Applicant fails to disclose any information regarding the system that may be material to the patentability of the disclosed invention. The Examiner reminds Applicants that they must disclose documents and publications known to them that are relevant to the subject matter of this application. In particular, copies of the first system that was implemented in October, 1994.

In response to this requirement, please provide the citation and a copy of each publication which any of the Applicants authored or co-authored and which describe the disclosed subject matter of obtaining securities information and transactions for a user at an automatic teller machine.

In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter and the disclosed prior art of obtaining securities information and transactions for a user at an automatic teller machine.

The fee and certification requirements of 37 C.F.R. 1.97 are waived for those documents

Serial Number: 09/006,839

Art Unit: 2164

submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. 1.105 are subject to the fee and certification requirements of 37 C.F.R. 1.97.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in Applicant's disclosure.

The Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the Applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is THREE months.



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100